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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STANLEY NG, CHRISTINE CHO,
and MONICA TRAN

Appeal 2016-004164
Application 12/493,961¹
Technology Center 3600

Before BRUCE R. WINSOR, ADAM J. PYONIN, and
MICHAEL M. BARRY, *Administrative Patent Judges*.

WINSOR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1–5, 7–12, and 18–23, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b). Claims 6 and 13–17 are cancelled. App. Br. (Claims App’x) 10, 12.

We affirm.

¹ The real party in interest identified by Appellants is Apple Inc. App. Br. 3.

STATEMENT OF THE CASE

Appellants' disclosed invention "is directed to providing social networking applications in shopping environments. In particular, this [invention] is directed to providing social networking applications operating on mobile devices by which users can share and receive information related to their shopping, such as purchase recommendations." Spec. ¶ 1.

Representative claim 1, which is illustrative, reads as follows:

1. A method for providing social networking services in a shopping context performed by one or more processors executing on an electronic device, comprising:

receiving a first input to a mobile device;

capturing, using a camera of the mobile device and in response to the receiving, data that is associated with an article available for sale from a non-virtual display of the article;

retrieving, using the mobile device and after the capturing, information from a remote server that identifies the article based on the captured data;

receiving, after the capturing, a second input to the mobile device that defines a request for a response regarding the article from at least one other electronic device; and

providing, using the mobile device, the retrieved information and the request to a social network that is associated with at least the mobile device and the at least one other electronic device.

Claims 1–5, 7–12, and 18–23 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. *See* Final Act. 2–4; Adv. Act.

2. There are no other outstanding rejections. *See* Final Act. 5. All pending claims are subject to a single common ground of rejection and are argued together (*see* App. Br. 6–9). Therefore, we select claim 1 as the

representative claim, pursuant to our authority under 37 C.F.R.
§ 41.37(c)(1)(iv) (2014).

Rather than repeat the arguments here, we refer to the Briefs (“App. Br.” filed Aug. 18, 2015; “Reply Br.” filed Mar. 7, 2016) and the Specification (“Spec.” filed June 29, 2009) for the positions of Appellants and the Final Office Action (“Final Act.” mailed Dec. 18, 2014), Advisory Action (“Adv. Act.” mailed May 13, 2015), and Examiner’s Answer (“Ans.” Jan. 05, 2016) for the reasoning, findings, and conclusions of the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

ANALYSIS

Patent eligibility is a question of law that is reviewable *de novo*. *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012). To be statutorily patentable, the subject matter of an invention must be a “new and useful process, machine, manufacture, or composition of matter, or [a] new and useful improvement thereof.” 35 U.S.C. § 101. The Supreme Court has held that there are implicit exceptions to the categories of patentable subject matter identified in § 101, including (1) laws of nature, (2) natural phenomena, and (3) abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). Further, the Court has “set forth a framework for distinguishing patents that claim [1] laws of nature, [2] natural phenomena, and [3] abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.*, citing *Mayo Collaborative Services v.*

Prometheus Laboratories, Inc., 132 S. Ct. 1289 (2012). The evaluation follows the two-part analysis set forth in *Mayo*: (1) determine whether the claim is directed to a patent-ineligible concept, e.g., an abstract idea; and (2) if an abstract idea is present in the claim, determine whether any element, or combination of elements, in the claim is sufficient to ensure that the claim amounts to significantly more than the abstract idea itself. *See Alice*, 134 S. Ct. at 2355.

The Examiner concludes that independent claim 1 recites a method, i.e., a process, and therefore falls within one of the statutory classes of patentable subject matter. Final Act. 3. Nevertheless, the Examiner concludes claim 1 is directed to a patent ineligible abstract idea. *Id.* We agree with the Examiner.

Considering the first step of the *Mayo/Alice* analysis, Appellants' invention is directed to shopping, and in particular to obtaining product information and getting advice from friends regarding potential shopping choices. Spec. ¶¶ 1–3. Claim 1 recites, in essence, identifying a product, accessing information about the identified product, and sharing the information about the identified product with a another person, doing so using a mobile device with a camera, a remote server, and a social network. *See App. Br. (Claims App'x) 10.* We note that Appellants' claim 1 is not directed to specific computer or network technology, but rather recites generalized steps relating to a process for which mobile devices with cameras, servers, and a network are used in their ordinary capacities as tools. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016) (“[T]he first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities

. . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.”).

Appellants contend claim 1 is not directed to an abstract idea because, *inter alia*, claim 1 is not directed to a “fundamental economic practice.” App. Br. 5–6; *see also* Reply Br. 5–7. We disagree. The process described in claim 1 is no more than a computerization of the well-established fundamental economic practice of shopping for a product, obtaining information about the product, and getting the input of an advisor (e.g., a friend). Appellants’ Specification describes this fundamental economic practice as follows:

When shopping in brick and mortar stores, such as in a mall, some users like having friends with them to look at items to purchase (e.g., clothing), and to get their friends’ recommendations and comments on proposed purchases. Similarly, some users rely on salespeople recommendations to select which items to purchase, or which items to try (e.g., which clothing or outfits to try on).

Spec. ¶ 2.

Comparing claim 1 to the claims at issue in *Alice* (intermediated settlement), *Bilski v. Kappos*, 561 U.S. 593, 609 (2010) (hedging risk), and *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014) (contractual arrangement guarantees), we conclude claim 1 is directed to a fundamental economic practice of “ancient lineage,” *buySAFE*, 765 F.3d at 1355, i.e., an abstract idea. *See Enfish*, 822 F.3d at 1334 (it is “sufficient to compare claims at issue to those claims already found to be directed to an abstract idea in previous cases”).

Turning to the second step of the *Mayo/Alice* analysis, we analyze the claim as a whole to determine whether any element, or combination of

elements, is sufficient to ensure that the claim amounts to significantly more than the exception. Appellants contend as follows:

Looking at the claims *as a whole*, humans aren't capable of mentally capturing the complete, accurate, and instantaneous data that a camera can capture. Furthermore, humans cannot send data about articles and feedback requests to a social network. A human can potentially send data to a target group of people. But that target group of people does not qualify as a "social network," because a social network is a specific computing environment that encompasses more people than one target group.

App. Br. 8.

We disagree with Appellants' conclusion. Each of the steps of claim 1 merely recites using conventional computer technology to perform entirely conventional steps. For example, as described in the Specification, "the user can capture or enter a barcode . . . associated with the article in the shop (e.g., a barcode on the article tag), where the link directs the device to retrieve an image or video, description, or both." Spec. ¶ 37. In other words, the user may use the camera to capture the barcode, or may enter the barcode manually, thereby "capturing the complete, accurate, and instantaneous data that a camera can capture." App. Br. 8. Appellants do not assert that capturing a barcode using the camera on a mobile device is any more than a conventional use of the camera on a mobile device. Furthermore, in the context of the claim, a "social network" is no more than a target group defined using a computer.

In other words, the claim merely recites the abstract idea and says "apply it" using computer technology. *See Mayo*, 132 S. Ct. at 1294; *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972). Appellants contend claim 1 does not preempt the recited abstract idea because "the claims are limited to

restricting very *concrete* uses of technology—capturing data about an article with a camera, using the captured data to retrieve information about the article from a server, and delivering the information and a feedback request to a social network.” App. Br. 8. That is, Appellants contend claim 1 does not preempt the abstract idea because it uses computer technology to perform the steps. However, limiting the abstract idea of shopping for a product, obtaining information about the product, and getting the input of an advisor, to the general purpose computer technology recited in Appellants’ claim 1 does not make the abstract idea patent-eligible under 35 U.S.C. § 101.

As recognized by the Supreme Court, “the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention.” *See Alice*, 134 S. Ct. at 2359 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” not patent eligible); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014) (claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet not patent eligible); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (claims reciting “generalized software components arranged to implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer” not patent eligible); and *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“[s]imply adding a ‘computer aided’ limitation to a claim covering an

abstract concept, without more, is insufficient to render [a] claim patent eligible” (internal citation omitted)).

We conclude claim 1 is directed to a patent-ineligible abstract idea and recites no element or combination of elements that amounts to significantly more than the abstract idea. Therefore we sustain the rejection of representative claim 1 and claims 2–5, 7–12, and 18–23, which fall with claim 1.

DECISION

The decision of the Examiner to reject claims 1–5, 7–12, and 18–23 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. §§ 41.50(f), 41.52(b).

AFFIRMED